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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,359	03/16/2001	Taeyoung Yoon	49662 [72021]	7721

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BOSTON, MA 02205

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/811,359

Applicant(s)

YOON ET AL.

Examiner

Tamthom N. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-22,30, 35,39-64 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,15,16,35,39-64 and 67 is/are allowed.
- 6) ☒ Claim(s) 3,5,6,9,11,14,17 and 30 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 8, 10, 12, 13 and 18-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

NON-FINAL ACTION

Applicant's amendment of 11-9-06 has been fully considered. Although claims 24-26 are now cancelled, and thus, render moot the previous rejection of 112/2nd paragraph, the scope of pending claims is still much too broad for a complete search. Thus, the previous restriction, and the election of group 1 are reinstated **without** the rejoining of other groups as previously indicated. Applicant is reminded that the **original** group 1 includes the following subject matter.

Group 1: Claims 1-8 (in part), 24-27 (in part), 30, 35 and 39-68, drawn to compounds of the formulae in claim 1, 2 or 3 having the following substituents:

Ar is phenyl or 1- or 2-naphthyl;

R₂ is **not** a heteroaryl or containing 3- to 7- membered heterocyclic group (i.e., Y and Z are not 3- to 7- membered heterocyclic group),

Also, drawn to composition thereof, and method of treating an anxiety disorder, stress-related disorder, or an eating disorder, Classified in classes 514 and 544, various subclasses depending on substituents.

Claims 2, 23-29, 31-34, 36-38, 65, 66 and 68 are cancelled.

Claims 18-22, 39-64 and 67 are withdrawn.

Although the original group 1 includes only claims 1, 3-8, 30 and 35, it is noted that claims 9 and 17-22 are also directed to a subset of compounds of claim 3. Thus, the withdrawn claims 18-22, 39-64 and 67 are now rejoined.

Claims 1, 3-22, 30, 35, 39-64 and 67 are considered herein.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 is of completely unknown since type of testing can be varied employing different ligands and other test conditions which may affect outcome and thus determining what is and what is not within the intended scope is not easily discernable. Further exacerbating the scope is the lack of guidance as to what would constitute a lack of “statistically significant activity”.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

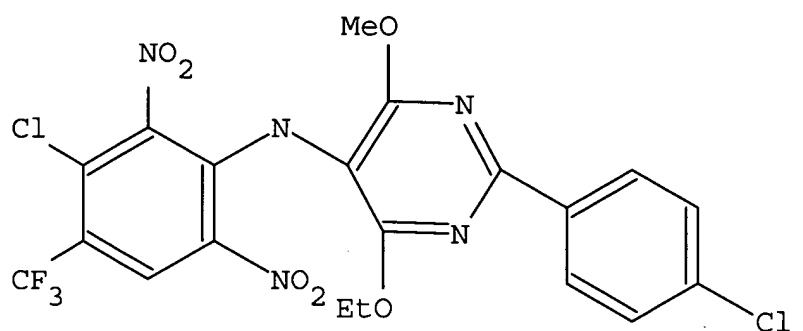
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

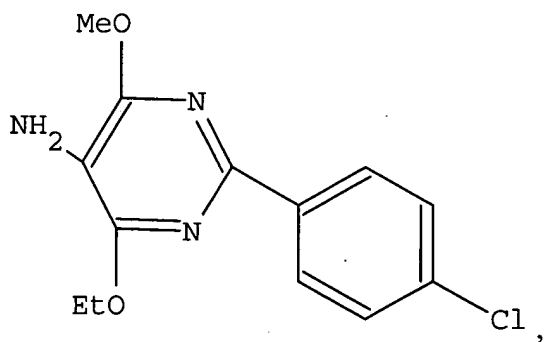
3. Claims 3, 5, 6, 9, 11, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by **Zondler et. al.** (US 4,840,662).
4. In columns 15 and 16, Table 1 lists several compounds (e.g. compounds 1.127, 1.134 and 1.135) that would necessarily have intermediates having the structure of formula III since the process in column 4 is the only way the final product is made. The disclosed formula III would

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process in column 4 is the only way the final product is made. The disclosed formula III would be encompassed by the instant formula. In particular, the compound 1.135 has the following structure:



Its intermediate would have the following structure:



which would be implicitly described and would fall within the scope of the formula recited in the instant claim 3 having the following substituents:

R_1 and R_3 , both represent $-O(C_{1-6}\text{alkyl})$ groups;

R_2 is $-NHR_A$, wherein R_A is hydrogen;

Ar is a phenyl group substituted with a halogen.

The same applies for other final products pointed out in Table 1.

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Claim Objections

5. Claims 4, 7, 8, 10, 12, 13 and 18-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Said claims require an alkylamino group at the position of R₂ which is not taught or fairly suggested by **Zondler et. al.** (US'662).

Allowable Subject Matter


4. Claims 1, 15, 16, 35, 39-64 and 67 are allowable because it recites pyrimidinyl compounds having the combination of substituents that is not taught or fairly suggested by the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamthom N. Truong

Examiner

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3-1-07

Emily Bernhardt (Acting)
EMILY BERNHARDT *SPF*
PRIMARY EXAMINER
GROUP 1600